


Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q80608	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/805,214	March 22, 2004	
	First Named Inventor Tsuyoshi NAKAMURA		
	Art Unit	Examiner	
	3652	Charles N. Greenhut	
WASHINGTON OFFICE 23373 CUSTOMER NUMBER			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number 41,574</p> <p> Signature</p> <p>Jeffrey A. Schmidt Typed or printed name</p> <p>(202) 293-7060 Telephone number</p> <p>December 21, 2006 Date</p>			



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q80608

Tsuyoshi NAKAMURA, et al.

Appln. No.: 10/805,214

Group Art Unit: 3652

Confirmation No.: 9125

Examiner: Charles N. Greenhut

Filed: March 22, 2004

For: POSITIONING DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated July 27, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claim Rejections - 35 U.S.C. § 103

(1) The Examiner rejected claims 1-3, 8, and 9, under §103(a) as being unpatentable over US Patent 6,120,609 to Selyutin (hereinafter Selyutin) in view of US Patent 4,726,689 to Pollock (hereinafter Pollock). Applicants respectfully traverse this rejection because the references fail to teach or suggest all of the elements as set forth and arranged in the claims.

First, Applicants' remarks as set forth in the Amendments as filed May 9 and April 21, 2006 are still pertinent and, therefore, are incorporated herein by reference.

Second, Selyutin fails to teach or suggest the claimed moving portion, i.e., wherein there is a differential pumping seal located between the case and the moving portion. Although

As shown in Fig. 10 of Selyutin, as reproduced and annotated here, one of ordinary skill in the art—following the teachings of Pollock—would have been motivated to provide a differential pumping seal between the connection portion (member 32) and the case (38). See, for example (DPS) as annotated into Selyutin's Fig. 10. That is, Pollock teaches a differential



pumping seal between shaft 10 that is moved into and out of case 50 through tube 40. Thus, one of ordinary skill in the art, following Pollock's teachings, would have provided the DPS between Selyutin's shaft 32 (connecting portion) and casing 38. Thus, the combination of Selyutin and Pollock would not include a differential pumping seal between a moving member and the case, as set forth in claim 1.

Third, the Examiner's use of Selyutin is improper. The Examiner fails to specify what element of Selyutin corresponds to the claimed moving portion. On page 4, item 3, of the office action, the Examiner asserts that since the "lift mechanism" is comprised of various elements, the lift mechanism can be considered as the claimed moving portion. However, just because a reference discloses many different elements, that does not mean that it includes a disclosure of a particularly claimed element. Instead, the Examiner has failed to explain the rejection with specificity, as he is required to do. As is set forth below with specificity, Selyutin fails to teach or suggest a moving portion as claimed.

In claim 1, the moving portion has three features as follows:

- (i) the moving portion is connected to the connecting portion outside of the process chamber;
- (ii) between the moving portion and the casing, a differential pumping seal is arranged;
- and
- (iii) the moving portion is supported by the base movably.

There is no member in Selyutin that meets all three features (i) to (iii) above so as to constitute a moving portion.

With reference to Fig. 1 (and Fig. 10) of Selyutin, and feature (i), one of the members connected to Selyutin's connecting portion 32 is base 34. Because the base 34 is clearly a separate element from the moving portion in claim 1, Selyutin's member 34 cannot correspond to the moving portion; it already corresponds to the base (compare element 238 of Fig. 10).

In analyzing the other members connected to the connecting portion 32:

- (a) the member 31 is connected to the connecting portion 32. However, a member corresponding to the differential pumping seal is not disclosed. Therefore, Selyutin's member 31 does not meet the feature (ii); and
- (b) the member 66 is constituted so as to be capable of separating from the connecting portion 32. Therefore, member 66 does not meet the feature (i).

No other members are connected to the connecting portion 32 (in Fig. 10, element 238 is the only one, outside of the process chamber, that is connected to connecting portion 32).

Therefore, Selyutin fails to teach or suggest the claimed moving portion.

The Examiner cites Pollock as teaching a differential pumping seal. However, Pollock fails to cure the above-noted deficiency in Selyutin. Accordingly, for the sake of argument alone, even assuming that one of ordinary skill in the art were motivated to combine Selyutin and Pollock as suggested by the Examiner, any such combination would still fail to render obvious Applicants' claim 1. Likewise, these references fail to render obvious the dependent claims 2, 3, 8, and 9.

(2) The Examiner rejected claims 4, 6, and 7, under §103(a) as being unpatentable over Selyutin in view of Pollock and further in view of US Patent 5,073,912 to Kobayashi (hereinafter Kobayashi). Applicants respectfully traverse this rejection because the references fail to teach or suggest all of the elements as set forth in the claims.

As noted above the Examiner's attempted combination of Selyutin and Pollock is deficient. The Examiner cites Kobayashi as teaching an electric drive. However, Kobayashi fails to cure the above-noted deficiency in Selyutin and Pollock. Accordingly, for the sake of argument alone, even assuming that one of ordinary skill in the art were motivated to combine Selyutin, Pollock and Kobayashi as suggested by the Examiner, any such combination would still fail to render obvious Applicants' claims.

(3) The Examiner rejected claim 5 under §103(a) as being unpatentable over Selyutin in view of Pollock and further in view of US Patent 2,908,472 to McDonald (hereinafter McDonald). Applicants respectfully traverse this rejection because the references fail to teach or suggest all of the elements as set forth in the claims.

As noted above the Examiner's attempted combination of Selyutin and Pollock is deficient. The Examiner cites McDonald as teaching a hydraulic drive. However, McDonald fails to cure the above-noted deficiency in Selyutin and Pollock. Accordingly, for the sake of argument alone, even assuming that one of ordinary skill in the art were motivated to combine

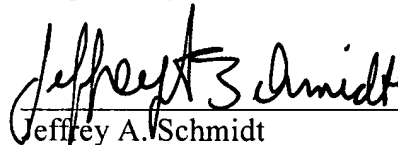
Selyutin, Pollock and McDonald as suggested by the Examiner, any such combination would still fail to render obvious Applicants' claim.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey A. Schmidt", is written over a horizontal line.

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